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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,402	03/08/2000	Mark L Yoseloff	PA0437.ap.US	1303

7590

04/21/2004

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EDINA, MN 55435

EXAMINER

MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
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3712

31

DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/520,402

Applicant(s)

YOSELOFF, MARK L

Examiner

Vishu K Mendiratta

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

1. Claims 1-19, 22-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (6132311) in view of Ornstein (5570885).

Williams teaches a method of playing a wagering game with at least at least two plays (abstract line 1), receiving at least one set of symbols (32,36,40), receiving a second set of symbols (32,36,50), comparing each set to symbols to the payout table (20), determining the ranks of first and second set of symbols whether they exceed a minimum rank ("two pair" in table 20). Resolving the wager with respect to first and second set of symbols (col.7, lines 5-10). Ornstein further teaches deck of playing cards (col.11, lines 21-22), poker ranks (20).

Williams teaches all limitations of these claims except that it does not teach resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table.

Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings (col.2, lines 17-21).

One of ordinary skill in art at the time the invention was made would have made the game more attractive for players by making an additional payoff for winning two or more plays consecutively. If a player knows that he would make additional money by winning two or more hands consecutively, he would be more interested in playing that game.

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Applicant might argue that hands 40 and 50 are not consecutive hands. Examiner takes the position that while practicing the game on a gaming table the turning of cards 40 and 50 would be consecutive (col.11, lines 1-8).

Examiner views applicant's variations in pay tables, minimum ranks and number of bets required for hands are choices of game houses and would change according to their financial situations. In order to make the game house profitable, it would have been obvious to change such limitations without changing the spirit of the game.

2. Claim 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Netley (5868618) in view of Ornstein (5570885).

Netley teaches a method of playing a poker game comprising the steps of wagering for each game (col.3, lines 13-14), playing at least two games (abstract), allowed to play a second game if winning the first game (col.2, lines 65-67), awards for winning both hands (col.3, lines 27-31), and bonus (col.3, lines 39).

Netley teaches all limitations of these claims except that it does not teach resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table.

Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings (col.2, lines 17-21).

One of ordinary skill in art at the time the invention was made would have made the game more attractive for players by making an additional payoff for winning two or more plays consecutively. If a player knows that he would make additional money by winning two or more hands consecutively, he would be more interested in playing that game.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 4, 15, 20, 23 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6179711 in view of Ornstein.

Yoseloff teaches all limitations of these claims except that it does not teach resolving a bet with respect when both first and second set of symbols exceed a minimum rank in the pay table.

Ornstein teaches a method of playing a game where a payoff is made for consecutive winnings (col.2, lines 17-21).

One of ordinary skill in art at the time the invention was made would have made the game more attractive for players by making an additional payoff for winning two or more plays consecutively. If a player knows that he would make additional money by winning two or more hands consecutively, he would be more interested in playing that game.

***Response to Arguments***

5. Applicant's arguments filed 2/9/04 have been fully considered but they are not persuasive.

Claims/arguments are unchanged from applicant's appeal brief paper # 21, dated 3/11/03.

Applicant is advised to see Supplemental examiner's answers paper # 25, dated 7/29/03.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishu K Mendiratta whose telephone number is (703) 306-5695. The examiner can normally be reached on Mon-Fri 8AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Vishu K Mendiratta  
Examiner  
Art Unit 3712

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A handwritten signature in black ink, appearing to be 'Jr' or similar, with a long horizontal stroke extending to the right.

VKM  
April 7, 2004